



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: )

John Eckl. ) Attorney Docket No.: F-278

Serial No.: N/A ) Group Art Unit: 2767

Filed: herewith )

For: BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION

DECLARATION UNDER 37 CFR §1.131

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Sir:

I, Lawrence E. Sklar declare as follows:

1. I was the Pitney Bowes Inc. patent attorney responsible for drafting and filing the United States patent application serial number 08/772,293, originally titled "Inserter Billing System With Electronic Distribution," (the "293 application"), which I understand to be the parent of the present application. The inventor for the '293 application was John Eckl, an employee of Pitney Bowes' Production Mail business unit.

2. The '293 application was filed on December 23, 1996. In this declaration, I will describe documentation and events demonstrating an earlier conception of the invention, and the subsequent continuous activities leading to the drafting and filing of the '293 application.

3. Prior to January 11, 1996, John Eckl prepared and submitted to the Intellectual Property and Technology Law Department of Pitney Bowes Inc. an invention disclosure describing an embodiment of the invention in the '293 application. A copy of the invention disclosure is attached hereto as Exhibit A. The invention disclosure was received by the Intellectual Property and Technology Law Department of Pitney Bowes Inc. on July 12, 1995 and was docketed for handling by the Intellectual Property and Technology Law Department in due course.

4. In early September, 1995, in accordance with the standard procedures of the Intellectual Property and Technology Law Department of Pitney Bowes Inc., a novelty search relating to the invention disclosure was conducted at the United States Patent and Trademark Office. As a result of the search various references were gathered and evaluated.

5. In 1996, I was responsible for intellectual property matters for the Production Mail business unit at Pitney Bowes. At that time, Production Mail was a large, self-contained, business unit having its own development and manufacturing facilities in Danbury, Connecticut and employing approximately 1,000 employees. Among the matters that I handled for the Production Mail business unit was John Eckl's invention disclosure. During 1996, for the Production Mail business unit, I was also responsible for evaluating new invention disclosures, prosecuting pending patent applications, supporting intellectual property and technology transactions and agreements, and reviewing products to ensure that new products did not infringe others' intellectual property. During 1996, I was responsible for negotiating a major, company-wide, software technology agreement worth millions of dollars for Pitney Bowes' infrastructure and supply chain management. During 1996 I was also responsible for company-wide trademark and copyright matters.

6. Pursuant to Pitney Bowes procedures, the Eckl invention disclosure and other invention disclosures were evaluated and discussed at regularly scheduled meetings of the Pitney Bowes Production Mail internal Patent Committee. The first meeting was in February of 1996. All disclosures were addressed in due course pursuant to standard investigation procedures, and were subsequently evaluated on the basis of their technical and business merits. At the February 1996 meeting it was decided to proceed with further evaluation and investigation of the Eckl invention. After a June 1996 meeting, a decision was made to proceed with preparing and filing a United States patent application based on the Eckl invention disclosure.

7. Pursuant to my ongoing investigation and drafting of the patent application for the Eckl invention disclosure, I sent a memorandum, dated August 6, 1996, asking John Eckl to consider U.S. Patent Nos. 4,941,091 and 5,283,829 with respect to his invention. A copy of the August 6, 1996 memorandum is attached hereto as Exhibit B.

8. After sending the August 6 memorandum to John Eckl, I remained in regular contact with him to discuss issues relating to the patent application. As can be seen on Exhibit B, I made handwritten notes dated August 8, 23, 27, and 29 and September 10 and 12 indicating various phone conversations that I had with John Eckl.

9. At my request, John Eckl also prepared a drawing of the invention which he completed on October 25, 1996 and a further narrative description of the invention which he forwarded to me on November 11, 1996. A copy of the October 25 drawing and November 11, 1996 memorandum are attached hereto as Exhibit C.

10. By memorandum dated November 20, 1996, I forwarded a draft of a patent application to John Eckl for review and comment. A copy of the November 20, 1996 memorandum is attached hereto as Exhibit D.

11. On December 6, 1996, John Eckl faxed (i) a mark-up of a claim of the draft patent application, and (ii) an addition to page 1 of the specification of the draft patent application. A redacted copy of the facsimile message is attached hereto as Exhibit E.

12. It is my belief that, from prior to January 11, 1996 until December 23, 1996, John Eckl, the Pitney Bowes Intellectual Property and Technology Law department, and myself worked diligently and reasonably toward the filing the '293 patent application in due course under the circumstances described herein.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Lawrence E. Sklar

Lawrence E. Sklar

6-30-01

Date